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EXAMINER

BORLINGHAUS, JASON M

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KAZUNORI UKIGAWA
and HIROKI YAMASHITA

Appeal 2009-007620
Application 09/775,591
Technology Center 3600

Decided: November 17, 2009

Before KENNETH W. HAIRSTON, HUBERT C. LORIN
and ANTON W. FETTING, *Administrative Patent Judges*.
HAIRSTON, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. §§ 6(b) and 134 from the final rejection of claims 1, 2, 5 to 13, 16, 18 to 20, 22, and 23.

We will reverse the obviousness rejections of claims 1, 2, 5 to 13, 16, 18 to 20, 22, and 23, and enter new grounds of rejection of claims 22 and 23.

Appellants have invented an online shopping system and method that uses an agent device for settlement of a user purchase from a merchant site. When a product purchase is made by the user at a merchant site, the agent device, at the request of the user, extracts stored credit card data that is used to settle an account at a settlement device for the product purchased from the merchant. By using the agent device, the user can avoid sending credit card data to the merchant (Figs. 1A, 4; Spec. 1 to 4, 22, 23, 25, 26; Abstract).

Claim 1 is representative of the claimed invention, and it reads as follows:

1. An online shopping system comprising:
 - at least one user device which is connected onto Internet and for reading a merchant site on the Internet;
 - an agent device which is connected to said at least one user device and the merchant site, relays and sends a purchase instruction from said at least one user device to the merchant site; and
 - a settlement device which is connected to said agent device, and settles an account for a product purchased in accordance with the purchase instruction sent from said at least one user device,
- said at least one user device including
 - purchase-instruction inputting means for inputting an instruction for purchasing a product on sale in the merchant site, and
 - a first purchase-instruction sending means for sending ID (identification) information of a user, as a first purchase instruction, together with information regarding the product input by said purchase-instruction inputting means to said agent device, and

said agent device including

user-information storage means for storing the ID information, user information regarding the user, and information regarding settlement means held by the user, in association with each other,

purchase-instruction receiving means for receiving the first purchase instruction sent from said first purchase instruction sending means,

user-information extraction means for searching said user-information storage means for user information based on the ID information of the user which is included in the first purchase-instruction, and extracting corresponding information regarding the user and corresponding information regarding the settlement means, when said purchaseinstruction receiving means receives the first purchase instruction,

second purchase-instruction sending means for sending, as a second purchase instruction, information regarding the product and being included in the first purchaseinstruction received by said purchase-instruction receiving means, and information regarding the user and being extracted by said user-information extraction means, to the merchant site, and

settlement requesting means for requesting said settlement device for settling an account for the purchased product, based on the information regarding the product and being included in the first purchase instruction received by said purchase-instruction receiving means and the information regarding the settlement means of the user and being extracted by said user-information extraction means.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Koreeda	US 5,890,137	Mar. 30, 1999
O'Leary	US 6,609,112 B1	Aug. 19, 2003 (filed Feb. 3, 2000)

Davis, *Pragmatics A Reader*, Oxford University Press, 1991, pp. 217 to 219.

Lomax, *Learning VB Script*, O'Reilly & Associates, Inc., 1997, pp. 457 to 459.

Dogac, *Current Trends in Data Management Technology*, Idea Group Publishing, 1999, pp. 41, 42.

The Examiner rejected claims 1, 2, 5, 6, 12, 13, 16, 20, and 23 under 35 U.S.C. § 103(a) based upon the teachings of Koreeda and O'Leary.

The Examiner rejected claims 7, 9 to 11, 18, and 22 under 35 U.S.C. § 103(a) based upon the teachings of Koreeda, Dogac, and Davis.

The Examiner rejected claims 8 and 19 under 35 U.S.C. § 103(a) based upon the teachings of Koreeda, Dogac, Davis, and Lomax.

In the obviousness rejection of claims 1, 2, 5, 6, 12, 13, 16, 20, and 23, the Examiner acknowledges (Final Rej. 4 and 5) that the online shopping system described by Koreeda does not have an agent device that includes “user-information storage means for storing the ID information, user information regarding the user, and information regarding settlement means held by the user, in association with each other,” “user information extraction means for searching said user-information storage means for user information based on the ID information of the user which is included in the first purchase-instruction, and extracting corresponding information regarding the user and corresponding information regarding the settlement

means, when said purchaseinstruction receiving means receives the first purchase instruction,” second purchase-instruction sending means for sending information regarding the user and “being extracted by said user-information extraction means” to the merchant site, and settlement requesting means for settling an account based on information “being extracted by said user-information extraction means.” According to the Examiner (Final Rej. 5 and 6), O’Leary describes an online shopping system that uses an agent device/wallet to perform the functions found lacking in the Koreeda. Based upon the teachings of O’Leary, the Examiner is of the opinion (Final Rej. 6) that it would have been obvious to one of ordinary skill in the art “to have modified Koreeda by incorporating a storage means for storing user information and settlement means information, as disclosed by O’Leary, and then extracting that information for use, as disclosed by O’Leary, to allow for minimal repeated user entry of information and automatic completion of forms.”

Appellants argue *inter alia* that the skilled artisan would not place the wallet 215 described by O’Leary in the service center 7/settlement network 6 described by Koreeda because the wallet 215 is used by O’Leary to make direct purchases from the merchant (App. Br. 28, 29), that the wallet 215 stores user pre-populated forms for use by the merchant (App. Br. 30, 31), and that “O’Leary’s ‘wallet 215’ is not an agent device with all the claimed features” (App. Br. 31).

Turning to the obviousness rejection of claims 7, 9 to 11, 18, and 22, the Examiner acknowledges (Final Rej. 10 and 11) that Koreeda does not describe a user device that includes product-information extraction means

that extracts settlement means information from a browsed merchant site, and a purchase-instruction sending means that sends the extracted information regarding the settlement means, along with other information, to an agent device. The Examiner contends (Final Rej. 11) that it would have been obvious to one of ordinary skill in the art to provide Koreeda with the ability to extract information from merchant websites based upon Dogac's teaching (p. 41) that "ShopBot is able to visit over a dozen of software vendors, extract product information, and summarize the results for the user." The Examiner also contends (Final Rej. 11) that it would have been obvious to the skilled artisan to modify the applied references "to allow for the extraction of information regarding settlement means to allow for individual sellers to specify settlement means and receive payment in said specified settlement means" based upon the publication to Davis "which references a potential patron calling a restaurant to inquire about acceptable forms of payment for a planned future purchase. (see The Caller's Plan, p. 218)."

Appellants argue (App. Br. 35) that the combined teachings of the references would not produce "a device that contains means for extracting information regarding a product to be purchased from contents of a browsed merchant site and information regarding specified settlement means."

ISSUES

Have Appellants demonstrated that the Examiner erred by finding that the skilled artisan would have modified Koreeda to include a storage means

(i.e., wallet 215) for storing user information and settlement means information as taught by O’Leary?

Have Appellants demonstrated that the Examiner erred by finding that the skilled artisan would have modified Koreeda to include means for extracting information from a merchant site as taught by Dogac, and to include means for specifying settlement means as taught by Davis?

FINDINGS OF FACT (FF)

1. As indicated *supra*, Appellants use an agent device to store information needed for settlement of a purchase made from a merchant site by a user device.
2. In the online shopping system described by Koreeda, a user 5 makes a purchase from a merchant 2a via computer network 4 (Fig. 1; col. 5, ll. 38 to 47; Abstract).
3. Koreeda uses a separate network (i.e., settlement network 6) for the user 5 to make settlement of the purchase. The settlement network 6 serves as an intermediary network between the user 5 and a service center 7 that is used to get approval of the purchase from approval center 13. After approval by the approval center 13, the service center 7 sends data to the merchant site 2a. Thereafter, the purchased product is delivered by the merchant site 2a to the user 5 (col. 5, ll. 47 to 59).
4. In O’Leary, a user at workstation 200 makes a purchase of a product from a merchant site 255 via wallet 215 (Fig. 2; col. 15, ll. 19 to 56).

5. O’Leary uses the wallet to store pre-populated fields of data (e.g., shipping address and name of the user) needed by the merchant site to complete the purchase (col. 15, ll. 56 to 59).

6. The publication by Dogac indicates that “ShopBot is able to visit over a dozen of software vendors, extract product information, and summarize the results for the user” (p. 41).

7. According to “The Caller’s Plan” described in the Davis publication, a potential patron can call a restaurant to make an inquiry about acceptable forms of payment for a possible future purchase (p. 218).

8. The Lomax publication states (pp. 457, 458) that “some shopping cart software utilizes a cookie file on your hard drive to store order information as you browse the store,” and “when you reach the virtual check-out counter, the cookie file is read back into the final order page.”

PRINCIPLES OF LAW

The Examiner’s articulated reasoning in the rejection must possess a rational underpinning to support a legal conclusion of obviousness. *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006).

ANALYSIS

Turning first to the obviousness rejection of claims 1, 2, 5, 6, 12, 13, 16, 20, and 23, we agree with the Examiner’s rationale (i.e., the use of a storage means for storing pre-populated fields of data (FF 5) “to allow for minimal repeated user entry of information and automatic completion of forms” (Final Rej. 6) for modifying the teachings of Koreeda with those of

O’Leary. In other words, we agree with the Examiner’s rationale to the extent that a storage means like the wallet 215 used between the user’s workstation 200 and the merchant site 255 in O’Leary (FF 4) would be used in the same location in Koreeda (i.e., between the user 5 and the merchant 2a (FF 2)). As argued by Appellants (App. Br. 28 to 31), O’Leary neither teaches nor would have suggested the placement of such a storage means in the settlement path described by Koreeda (FF 3). The Examiner’s articulated reasoning in the rejection must possess a rational underpinning to support a legal conclusion of obviousness. *Kahn*, 441 F.3d at 988. Thus, the obviousness rejection of claims 1, 2, 5, 6, 12, 13, 16, 20, and 23 is reversed because “O’Leary’s ‘wallet 215’ is not an agent device with all the claimed features” acknowledged as being missing in Koreeda (App. Br. 31).

Turning next to the obviousness rejection of claims 7, 9 to 11, 18, and 22, we agree with the Appellants’ argument that Dogac’s teaching that “ShopBot is able to visit over a dozen of software vendors, extract product information, and summarize the results for the user” (FF 6) and Davis’ “The Caller’s Plan” for making an inquiry about acceptable forms of payment for a possible future purchase (FF 7), when combined with Koreeda, would neither teach nor would have suggested “a device that contains means for extracting information regarding a product to be purchased from contents of a browsed merchant site and information regarding specified settlement means” for that product (App. Br. 35). Accordingly, the obviousness rejection of claims 7, 9 to 11, 18, and 22 is reversed because we do not agree with the Examiner’s rationale (Final Rej. 11) for combining the disparate teachings of the applied references.

The obviousness rejection of claims 8 and 19 is reversed because the shopping cart and cookie file teachings of Lomax (FF 8) do not cure any of the noted shortcomings in the teachings of Koreeda, Dogac, and Davis.

NEW GROUNDS OF REJECTION

Claims 22 and 23 are rejected under 35 U.S.C. § 101 for being directed to nonstatutory subject matter. A claim directed to a signal (i.e., “[a] program data signal embodied in a carrier wave”) does not fit within at least one of the four statutory subject matter categories under 35 U.S.C. § 101. *In re Nuijten*, 500 F.3d 1346, 1357 (Fed. Cir. 2007).

CONCLUSIONS OF LAW

Appellants have demonstrated that the Examiner erred by finding that the skilled artisan would have modified Koreeda to include a storage means (i.e., wallet) for storing user information and settlement means information as taught by O’Leary.

Appellants have demonstrated that the Examiner erred by finding that the skilled artisan would have modified Koreeda to include means for extracting information from a merchant site as taught by Dogac, and to include means for specifying settlement means as taught by Davis.

ORDER

The decision of the Examiner rejecting claims 1, 2, 5 to 13, 16, 18 to 20, 22, and 23 under 35 U.S.C. § 103(a) is reversed.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 C.F.R. 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that the Appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

REVERSED; 37 C.F.R. § 41.50(b)

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